

REMARKS

Claims 109, 113 and 121 are amended, no claims are canceled or added; as a result, claims 10-35 and 109-129 are now pending in this application.

Applicant notes that the examiner renumbered claims 117-121 as 125-129.

§112 Rejection of the Claims

Claims 109-124 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses.

One of ordinary skill in the art would find the specification as an adequate teaching of how to make and use the present invention. More specifically, the Office Action does not set forth a prima facie case of non-enablement by the specification. The specification teaches each step as recited in claim 109. First, a claim can provide its own support. Independent claims 109, 113, 115, 117, 121 and 123 each provide their own support. Second each of the steps in the claims are supported by the drawings. Figures 1-8 show forming a conductive container structure having a closed bottom and sidewalls extending upward from the closed bottom as recited in claim 109. Figures 7 and 8 show an embodiment of the step of forming a dielectric cap on a top of the sidewalls as recited in claim 109. Figures 10-12 show a further embodiment of the step of forming a dielectric cap on a top of the sidewalls as recited in claim 109. Accordingly, claim 109 is enabled by the specification.

The Office Action states that “in the absence of a fill layer [15] formed inside the conductive container structure with a level below a top of the insulating layer [50] formed outside of the conductive container structure, which are necessary critical or essential to the practice of the invention . . . [reference numbers added]” The present specification teaches that the fill layer 15 need not be below the top of insulating layer 50. See, for example, Figures 5-7. Accordingly, the specification does enable all of the pending claims. Withdrawal of the section 112, first paragraph rejection is requested.

Claims 10-22 & 109-129 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, and/or first paragraph, as it does not reasonably provide enablement for the claimed method. Applicant respectfully traverses.

The Office Action sets forth its reasons for this rejection spanning pages 2-3. In sum, it appears that the claims are rejected on a belief that a dependent claim claiming that the parent method claim must be performed in the recited order renders the parent claim unclear. This is a mistaken belief. The parent claims are not written in a manner that limits the claims to any particular order of the steps. It appears that the examiner is attempting to restrict the claims beyond the explicit words in the claims and is not interpreting the transitional phrase "comprising" in its customary interpretation. MPEP 2111.03 states

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Accordingly, dependent claims 11, 110, 114, 116, 118, and 122 further restrict elements of their parent claims by placing temporal limits on when subsequent steps, as listed in the claims, can be performed. Withdrawal of the Section 112, second paragraph rejection is requested.

Reservation of the Right to Swear Behind References

Applicant maintains its right to swear behind any references which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.

§102 Rejection of the Claims

Claims 109, 110, 113, 114, 117, 118, 121 & 122 were rejected under 35 USC § 102(b) as being anticipated by Dennison (U.S. 5,206,183). Applicant traverses.

Claim 109 recites, in part, “using the dielectric cap as part of the dielectric layer.” Applicant can not find this feature in Dennison. Accordingly, claim 109 is believed to be allowable over Dennison. Reconsideration and allowance of claim 109 and claim 110 depending therefrom are requested.

Claim 113 recites, in part, “forming a dielectric layer on the container structure using the dielectric cap as part of the dielectric layer.” Applicant can not find this feature in Dennison. Accordingly, claim 113 is believed to be allowable over Dennison. Reconsideration and allowance of claim 113 and claim 114 depending therefrom are requested.

Claim 117, in part, recites “forming a dielectric layer on the conductive container structure and including the dielectric cap”. Applicant can not find this feature in Dennison. Accordingly, claim 117 is believed to be allowable over Dennison. Reconsideration and allowance of claim 117 and claim 118 depending therefrom are requested.

Claim 121, in part, recites “wherein forming the dielectric layer includes incorporating the dielectric cap in the dielectric layer”. Applicant can not find this feature in Dennison. Accordingly, claim 121 is believed to be allowable over Dennison. Reconsideration and allowance of claim 121 and claim 122 depending therefrom are requested.

§103 Rejection of the Claims

Claims 117, 118, 121 & 122 were rejected under 35 USC § 103(a) as being unpatentable over Dennison (U.S. 5,206,183) and Clampitt (6,150,691). Applicant respectfully traverses.

64 The present application and U.S. Patent No. 6,150,691 issued to Clampitt were, at the time the invention of the present application was made, owned by Micron Technology, Inc. Applicant submits that Clampitt is not prior art against the present application under 35 U.S.C. Section 103(c). Reconsideration and allowance of claims 117, 118, 121 & 122 are requested. ✓

Claims 10, 15-17 & 20 were rejected under 35 USC § 103(a) as being unpatentable over Figura et al. (6,255,687) in view of Dennison et al. (5,888,877) and Chen (6,077,743). Applicant respectfully traverses.

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The present application and U.S. Patent No. 6,255,687 issued to Figura were, at the time the invention of the present application was made, owned by Micron Technology, Inc. Applicant submits that Figura is not prior art against the present application under 35 U.S.C. Section 103(c). Reconsideration and allowance of claims 10, 15-17 & 20 are requested.

Claims 18, 19, 22 & 109-116 were rejected under 35 USC § 103(a) as being unpatentable over Figura et al. (6,255,687) in view of Dennison et al. (5,888,877) and Chen (6,077,743) as applied to claims 10 & 20 above, and further in view of Abernathey et al. (4, 725, 560). Applicant respectfully traverses.

The present application and U.S. Patent No. 6,255,687 issued to Figura were, at the time the invention of the present application was made, owned by Micron Technology, Inc. Applicant submits that Figura is not prior art against the present application under 35 U.S.C. Section 103(c). Reconsideration and allowance of claims 18, 19, 22 & 109-116 are requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 349-9587) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

GURTEJ S. SANDHU ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 349-9587

Date

25 Aug '03

By

Timothy B. Clise
Reg. No. 40,957

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 25th day of August, 2003.

Name

Amy moriarty

Signature

Amy moriarty